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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/469,812	12/22/1999	MAARTEN H. STUIVER	SYN-014	5404
28393	7590	03/23/2005	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVE., N.W. WASHINGTON, DC 20005			KRUSE, DAVID H	
			ART UNIT	PAPER NUMBER
			1638	

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/469,812

Applicant(s)

STUIVER ET AL.

Examiner

David H Kruse

Art Unit

1638

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 01 March 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) a set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL concurrently with

2. ☒ The reply was filed ~~after the date of filing~~ a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on 01 March 2005. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ has been ~~will be~~ entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____
- Claim(s) objected to: 13.
- Claim(s) rejected: 1,2,4-6,8,9,11 and 14-32.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.


David H Kruse
Examiner
Art Unit: 1638

Continuation of 5. Applicant's reply has overcome the following rejection(s): the rejection under 35 USC 112, first paragraph, for enablement of claims 2 and 13; the rejection of claims 1,2,4-6,8,9, 11 and 13 under 35 USC, 112, second paragraph.

Continuation of 11. does NOT place the application in condition for allowance because: Applicant argues that because the specification, on pages 10-11, describe the Sal I site is located 10 bp adjacent to the left border, that the limitation "which is within about 5 kb of the left border" is adequately described (page 11 of the Remarks). This argument is not found to be persuasive because the limitation in claims 20 and 29 is not supported by such a description, hence the claims remain rejected as containing New Matter. Claims 1,4,6 and 8-11 remain rejected and new claim 31 would be rejected under 35 USC 112, first paragraph, for failing to comply with the written description requirement. Applicant argues that claims of the instant invention are drawn to novel plant vectors that comprise a group of nucleotide sequences that interfere with DNA unwinding, and that such sequences are well known in the art (pages 11-13 of the Remarks). This argument is not found to be persuasive for the reasons of record. Claims 1, 4, 8, 9 and 11 remain rejected and claims new 31 and 32 would be rejected under 35 USC 112, first paragraph for lack of adequate enablement. Applicant argues that it would not require undue trial and error experimentation to practice the claimed invention as directed to use of a "nucleotide sequence that interferes with DNA unwinding" (pages 13-15 of the Remarks). This argument is not found to be persuasive for the reasons of record. Applicant has only taught a few examples known in the art of nucleotide sequences that can interfere with DNA unwinding, but these examples do not have a recognizable common structure by which one of skill in the art could interpret what others could be used in the invention as broadly claimed. Claims 1,2,8,11,12 and 14-29 remain rejected and claim 30 would be rejected under 35 USC 102(g). Applicant's arguments on page 12 of the Remarks have all been previously addressed in the previous Office action. Claim 9 remains rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,421,458. Applicant's arguments on page 18 of the Remarks have been addressed in the previous Office action. Claims 1, 4, 5, 9 and 11 remain rejected and new claim 31 would be rejected under 35 U.S.C. § 103(a) as being unpatentable over Ramanathan et al (Plant Molecular Biology 1995, 28: 1149-1154) in view of D'Souza-Ault et al (1993, J. Bacteriology 175(11): 3486-3490). Applicant argues that Ramanathan does not state with any specificity whatsoever what such a "stop-transfer" signal would look like. Ramanathan does not teach or suggest any category of "stop-transfer" signal (page 19 of the Remarks). Applicant argues that D'Souza-Ault does not teach that the VirG sequence acts as a repressor of transcription (page 19 of the Remarks). These arguments are not found to be persuasive because D'Souza-Ault teaches the Vlr box sequence is the target of VirG which represses expression and functions as a repressor at page 3489, right column. Claim 13 would be allowable if rewritten in independent form incorporating all of the limitations of the claim(s) upon which it depends.

DAVID H. KRUSE, PH.D.
PRIMARY EXAMINER

